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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/339,634	06/24/1999	SCOTT C. COTTRILLE	777.204US1	2835

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CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC
1420 FIFTH AVENUE
SUITE 2800
SEATTLE, WA 98101-2347

EXAMINER

ROMERO, ALMARI DEL CARMEN

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 01/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/339,634

Applicant(s)

COTTRILLE ET AL.

Examiner

Almari Romero

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. This action is responsive to communications: Amendment filed on 10/31/02 and Interview Summary filed on 9/09/02.
2. The references submitted as IDS filed on 6/24/99 are all considered based on Applicant's remarks on page 4, 1st paragraph, affirming "...that it is applicant's understanding that these references were publicly available at least as early as the date on which they were printed, namely March 20, 1999".
3. The objection to the abstract of the disclosure has been withdrawn as necessitated by amendment.
4. The objection to the specification regarding related applications has been withdrawn as necessitated by amendment.
5. The rejection of claims 1-19 under 35 U.S.C. 103(a) as being unpatentable over Yehuda and Sidana has been withdrawn in light of newly found art.
6. Claims 1-19 are pending in the case. Claims 1, 7, and 16 are independent claims.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. **Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by van Hoff (USPN 5,822,539 - filed on 12/1995).**

Regarding independent claim 7, van Hoff discloses:

A scalable method of presenting an annotation associated with a content source, the method comprising:

 sending a document identifier for a content source to a tier I server, said tier I sever being part of a multiple tier computing system that also includes a tier II server (van Hoff on col. 5, lines 1-32 and col. 6, lines 34-57, see figure 2: teaches annotation with a unique identifier to retrieve requesting document; annotations are retrieved from an annotation proxy (tier server I) and document retrieved from a web server (tier server II)); and

 receiving a first response from the tier I server, said first response comprising an indication of whether one or more annotations are associated with the document identifier and a reference to said tier II server, said tier II server maintaining additional information for each one of the annotations associated with the document identifier (van Hoff on col. 5, lines 1-32 and col. 6, lines 34-57, see figure 2: teaches the annotation proxy server (tier I) receives the client requests, each annotations are uniquely identified to be associated with requesting document which can be located and retrieved from a web server (tier server II)).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-6 and 8-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over van Hoff (USPN 5,822,539 - filed on 12/1995) in view of Van Der Meer (USPN 6,289,362 B1 - filed on 9/1998).

Regarding independent claim 1, van Hoff discloses:

A scalable method of associating an annotation with a content source, the method comprising:

representing an annotation having a plurality of properties wherein one of the plurality of properties is a document identifier property (van Hoff on col. 5, lines 1-32: teaches annotation having a unique identifier); and

associating the annotation with a content source using the document identifier property wherein the document identifier property identifies the content source with which the annotation is associated, wherein the annotation is retrievable from an annotation server in a multiple tier computing system (van Hoff on col. 5, lines 1-32 and col. 6, lines 34-57, see figure 2: teaches associating annotation with requesting document; annotations are retrieved from an annotation proxy server).

However, van Hoff does not explicitly disclose, "annotation as an object".

Van Deer Meer on col. 2, lines 44-52: teaches object including annotation.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Van Deer Meer into van Hoff to provide an object including annotation incorporated to the annotation associated with a document and retrieved from a server which will advantageously enable the content provider (server) to maintain a control of objects (annotations) displayed to the user.

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Regarding dependent claim 2, Van Deer Meer discloses:

wherein the act of representing the annotation as an object having a plurality of properties further comprises defining generic properties of the annotation (Van Deer Meer on col. 11, lines 25-32: teaches define annotation e.g. link data, expiration data, etc.).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Van Deer Meer into van Hoff to provide an object including annotation incorporated to the annotation associated with a document and retrieved from a server which will advantageously enable the content provider (server) to maintain a control of objects (annotations) displayed to the user.

Regarding dependent claim 3, Van Deer Meer discloses:

wherein the generic properties are selected from the group consisting of type, content, author name, creation time, modify time, time to-live, document identifier, index and parent identifier (Van Deer Meer on col. 11, lines 25-32: teaches define annotation e.g. link data, expiration data, etc., (which may include creation time, modify time, etc.)).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Van Deer Meer into van Hoff to provide an object including annotation incorporated to the annotation associated with a document and retrieved from a server which will advantageously enable the content provider (server) to maintain a control of objects (annotations) displayed to the user.

Regarding dependent claim 4, Van Deer Meer discloses:

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wherein the type property of the annotation is selected from the group consisting of: a text file, a threaded message, an audio file, a video file, a calendar file, and a chat (Van Deer Meer on 4, lines 37-60: teaches objects as cartoon characters, company advertisements, etc.).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Van Deer Meer into van Hoff to provide an object including annotation incorporated to the annotation associated with a document and retrieved from a server which will advantageously enable the content provider (server) to maintain a control of objects (annotations) displayed to the user.

Regarding dependent claim 5, van Hoff discloses:

wherein the act of representing the annotation as a object having a plurality of properties further comprises define one or more type specific properties unique to the type property of the annotation (van Hoff on col. 5, lines 1-32: teaches annotations having a unique identifiers) and (Van Deer Meer on col. 11, lines 25-32: teaches define annotation e.g. link data, expiration data, etc. (different types of properties).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Van Deer Meer into van Hoff to provide an object including annotation incorporated to the annotation associated with a document and retrieved from a server which will advantageously enable the content provider (server) to maintain a control of objects (annotations) displayed to the user.

Regarding dependent claim 6, van Hoff discloses:

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wherein the document identifier is selected from the group consisting of: a file name, a directory path, and a uniform resource locator (van Hoff on col. 2, lines 1-26: teaches unique identifier as an URL).

Regarding dependent claims 8 and 9, van Hoff discloses:

displaying the first response in a manner that is non-intrusive or intrusive to the content source (van Hoff on col. 3, lines 17-21: teaches annotation proxy server similar to a firewall proxy (to filter non-intrusive or intrusive requested documents)).

Regarding dependent claim 10, van Hoff discloses:

sending a request to the tier II server for additional information for one of the annotations associated with the content source; and receiving a second response from the tier II server, said second response comprising one or more properties for the annotation (van Hoff on col. 5, lines 1-32 and col. 6, lines 34-57, see figure 2: teaches the web server (tier II server) containing requested documents or other information to be associated with annotations retrieved from an annotation proxy server).

However, van Hoff does not explicitly disclose, "reference to a tier III server".

Van Deer Meer on col. 4, lines 37-60: teaches a presentation context server (not shown in figure 1) (as tier III server) in communication with the diary server (tier II sever).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Van Deer Meer into van Hoff to provide a presentation context server (not shown in figure 1) (as tier III server) incorporated as a different type of server in communication with the web server (tier II) containing documents and other information to be

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associated with annotations which will enhance the presentation of data by controlling the data displayed to the user.

Regarding dependent claims 11 and 12, van Hoff discloses:

further comprising displaying the one or more properties for the annotation in a manner that is non-intrusive or intrusive to the content source (van Hoff on col. 3, lines 17-21: teaches annotation proxy server similar to a firewall proxy (to filter non-intrusive or intrusive requested documents)).

Regarding dependent claim 13, Van Deer Meer discloses:

sending to tier III server an annotation identifier for the annotation associated with the content source; and receiving a third response from the tier III server, wherein the third response comprises a body for the annotation identified by the annotation identifier annotation (Van Deer Meer on col. 4, lines 9-60: teaches a presentation context server (not shown in figure 1) (as tier III server) in communication with the diary server (tier II sever) to retrieve template associated with the object including annotation).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Van Deer Meer into van Hoff to provide a presentation context server (not shown in figure 1) (as tier III server) incorporated as a different type of server in communication with the web server (tier II) containing documents and other information to be associated with annotations which will enhance the presentation of data by controlling the data displayed to the user.

Regarding dependent claims 14 and 15, van Hoff discloses:

further comprising displaying the body for the annotation identified by the annotation identifier in a manner that is non-intrusive or intrusive to the content source (van Hoff on col. 3, lines 17-21: teaches annotation proxy server similar to a firewall proxy (to filter non-intrusive or intrusive requested documents)).

Regarding claims 16-19, the limitations of claims 16-19 are a computer readable medium for processing the method of claims 1-6 and 8-15 and are rejected under the same rationale.

Response to Arguments

11. Regarding Applicant's arguments filed on 10/31/02 are moot in view of the new ground(s) of rejection.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USPN 5,826,025 – Gramlich – issued on 10/1998

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Almari Romero whose telephone number is (703) 305-5945. The examiner can normally be reached on Mondays - Fridays (7:30am - 4:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (703) 308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

AR

January 9, 2003


HEATHER R. HERNDON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100